



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/529,383	08/10/2000	Gerd Meier	306.38372X00	7054

20457 7590 04/05/2002

ANTONELLI TERRY STOUT AND KRAUS
SUITE 1800
1300 NORTH SEVENTEENTH STREET
ARLINGTON, VA 22209

EXAMINER

NGUYEN, TRINH T

ART UNIT	PAPER NUMBER
----------	--------------

3726

DATE MAILED: 04/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/529,383

Applicant(s)
Meier et al.

Examiner
Trinh Nguyen

Art Unit
3726



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Jan 24, 2002.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-15 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-15 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

20) ☐ Other:

Art Unit:

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The method steps in claims 1-15 are incorrect and indefinite because: 1) there are no positively and manipulatively claimed method steps; and 2) the method steps should be written in an active forms, i.e., verbs with an -ing- suffix should be used.

In claims 6 and 7: "the outside" lacks proper antecedent basis.

In claim 14: "the method is used" is confusing because it is not understood what "method" is being used.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit:

4. Claims 1-3 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Adachi et al. (US 5,860,401).

Adachi et al. teach a method of increasing the wear-resistance of a work piece of a valve system used in automotive engines by form-fitting by means of hot-extrusion an insert/core member/material (46, 67) which has a greater hardness than the work piece (noted that the insert/core member/material is formed from a sintered iron (which is a hard metal) and the work piece is formed from aluminum alloy) to the work piece (42) (see Figures 6-10 and lines 50-65 of col. 7).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4-13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adachi et al. (US 5,860,401).

Regarding claim 4, Adachi et al. teach the claimed invention except for the specific article design limitation, i.e., the specific ceramic sintered material. However, such limitation must results in a manipulative difference in the recited process steps as compared to the prior art. In this instance this design limitation is held to be obvious and not given patentable weight in

Art Unit:

these method of manufacturing claims as such limitation(s) do not result in any difference in the *claimed* manufacturing process.

Regarding claims 5-7 and 15, Adachi et al. teach the claimed invention except for the specific article design limitations, i.e., the specific shaped elements namely round-off notches, hollow spaces, undercuts, knurling, and/or tapers. However, such limitations must result in a manipulative difference in the recited process steps as compared to the prior art. In this instance these design limitations are held to be obvious and not given patentable weight in these method of manufacturing claims as such limitation(s) do not result in any difference in the *claimed* manufacturing process.

Regarding claims 8-13, Adachi et al. teach the claimed invention except for the specific structure limitations, such as a bore, a displaceable punch, an extrusion sleeve liner, a displaceable ejector, a constriction, a hollow punch, a clearance, and a further displaceable punch. However, such limitations must result in a manipulative difference in the recited process steps as compared to the prior art. In this instance these design limitations are held to be obvious and not given patentable weight in these method of manufacturing claims as such limitation(s) do not result in any difference in the *claimed* manufacturing process.

Response to Arguments

7. Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit:

Conclusion

8. Official documents related to the instant application may be submitted to the Technology Center 3700 mail center by facsimile at (703) 305-3579/3580.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1148.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trinh Nguyen whose telephone number is (703) 306-9082.

Handwritten signature
Apr 3 7 00

ttn

April 2, 2002